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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,720	09/29/2006	Isamu Koyama	740819-1160	9395

78198 7590 02/04/2011  
Studebaker & Brackett PC  
One Fountain Square  
11911 Freedom Drive, Suite 750  
Reston, VA 20190

EXAMINER
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SZPIRA, JULIE ANN

ART UNIT	PAPER NUMBER
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3731

NOTIFICATION DATE	DELIVERY MODE
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02/04/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

info@sbpatentlaw.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/594,720	KOYAMA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	JULIE A. SZPIRA	3731	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 November 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-7 and 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

Receipt is acknowledged of applicant's amendment filed 11/21/2010. Claims 1, 2, 4-7 and 10 are pending and an action on the merits is as follows.

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. **Claims 1, 2, 4-7 and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Nichols (US 3,088,466)** in view of **Jones (US 4,278,081)**, further in view of **Toy (US 3,511,243)**.

**Regarding claims 1, 2 and 4-7**, Nichols discloses a supporting device capable of supporting insertion of a medical instrument into a human body, comprising: a tubular member (1) includes a tubular member engagement section (15), the tubular member further includes an inner passageway between its opposite ends through which the medical instrument is capable of passing, wherein the tubular member is configured to

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guide the medical instrument into a digestive organ from an oral cavity through a pharynx, the tubular member is formed in a curved shape (Figure 1) in advance to conform to the shape of pharynx, and the tubular member has a diameter that is larger than that of the pharynx to allow an expansion of the pharynx; a guiding member (3) configured to guide the tubular member and the reinforcement member, the guiding member includes a guiding member engagement section (13) and the guiding member has a diameter smaller than that of the inner passageway, and when inserted from an oral cavity into the pharynx and retained there, the tubular member can guide the medical instrument to the digestive organ through the inner passageway, and such that when the guiding member engagement section is engaged with the tubular member engagement section, the digestive organ end of the guiding member is generally coincident with the digestive organ end of the tubular member (column 4, line 71 - column 5, line 5), but fails to disclose the tubular member having a slanted distal end, containing a reinforcement element, a second guiding member and the diameter of the tubular member being greater than 20mm.

However, Jones teaches a tubular member with a slanted distal end, (Figure 2) molded to contain a spiral reinforcement element (70) therein that extends within the inner passageway along a longitudinal centerline, but does not extend past the distal end of the tubular member (column 7, line 66-column 8, line 10).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the tubular member having a slanted distal end and including a spiral reinforcement member to support the patency of the lumen of the

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tubular member, while still allowing a degree of flexibility, while reducing pressure at the distal end of the device (column 8, lines 3-7; the slanted end does not exert pressure 360° within the tubular organ at the distal end, thus relieving the pressure at that end).

Toy teaches a first guiding member (2) and a second guiding member (14) and a tubular member (10) that fits over the first and second guiding members (Figures 7-9), wherein the tubular member diameter is greater than 20mm (column 3, lines 45-48; 2 inches is approximately 50mm).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use two guiding tubes to provide a gradual expansion of the lumen in which the device is placed (column 3, lines 20-31). The initial insertion of first guiding member (2) would dilating the lumen to a first diameter, second guiding member (14) would slightly enlarge that diameter and finally the tubular member would be the largest in diameter, fitting over both the first and second guiding member to enlarge the lumen to the final diameter.

The prior art of record does not specifically disclose the device being used to dilate a pharyngeal lumen, but it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex Parte Masham*, 2 USPQ F.2d 1647 (1987). The devices disclosed in the prior art have the structural capability of being used to dilate a pharynx. The dual guiding tubes disclosed by Toy are used to gradually dilate an opening in a body lumen. Toy further discloses a third element (24; also including a distal end is that is slanted

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with respect to the center line of the device) that could be used as a guiding member.

The use of the device disclosed in prior art does not have to be exactly the same as in the present invention, so long as the structure of the device can perform the claimed tasks.

**Regarding claim 10**, Nichols discloses the tubular member and the guiding member made of a variety of materials (column 1, lines 34-50), but fails to specifically disclose the guiding member made of a resin material harder than that of the tubular member.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the guiding member of a resin material harder than that of the tubular member, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

### ***Response to Arguments***

4. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JULIE A. SZPIRA whose telephone number is (571) 270-3866. The examiner can normally be reached on Monday-Thursday 9 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/J. A. S./  
Examiner, Art Unit 3731  
January 26, 2011

/TODD E. MANAHAN/

Supervisory Patent Examiner, Art Unit 3776